

REMARKS/ARGUMENTS

In response to the Final Office Action mailed January 7, 2005, Applicant proposes to amend his application and requests reconsideration in view of the proposed amendments and the following remarks. In this amendment, claims 1 and 8 have been proposed to be amended, no claims have been cancelled without prejudice and no claims have been added so that claims 1, 2 and 4-8 remain pending.

Claims 1, 2, 4-8 were rejected as being unpatentable over U.S. Patent No. 5,690,644 to Yurek et al. (Yurek) in view of U.S. Patent No. 5,647,858 to Davidson (Davidson). This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

Yurek et al. discloses an apparatus for deploying self-expanding stents. The apparatus comprises an exterior catheter made from a thermoelastic elastomer and an interior catheter. The exterior and interior catheter are designed such that the coefficient of friction of the exterior catheter along its interior surface is less than the coefficient of friction of the interior catheter along its exterior surface such that the stent does not move during deployment. In an alternate embodiment, the stent is confined in a reduced radius configuration by a rolling membrane constructed of a suitable elastomer. The membrane has multiple layers, with one layer bonded to the exterior catheter and the other bonded to the interior catheter. A lubricious material is used between the layers for ease of deployment.

Davidson discloses metallic catheters that may be coated with a layer of blue to black zirconium oxide or zirconium nitride. For guide wire applications, the internal catheter construct for guiding a wire or other apparatus in a solid thin tube of low modulus alloy, or a coiled low modulus alloy wire, encased in a polymer sleeve. Hard oxide or nitride ceramic surface layer over the surfaces of the low modulus alloy construct provides a low friction surface to aid in the insertion and control of a guide wire.

The references, whether taken alone or in combination, fail to disclose or suggest the claimed invention. The references fail to disclose an outer sheath formed from two distinct layers; namely, a polymeric layer and a pyrolytic carbon and/or ceramic layer in combination with an inner shaft. The lubricious inner layer is configured to prevent the stent from becoming embedded in the substantially tubular sheath. The references fail to disclose this feature.

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Individual pieces are suggested in the references, but the claim as a whole is not taught by the two references. Davidson discloses lining a metal tube with a polymer and a ceramic for reducing friction for guide wires. Yurek discloses inner and outer members with a lubricious material sandwiched therebetween but neither discloses a configuration for preventing emdebbing while providing a lubricious surface.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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